

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 28

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte BRETT P. SEBER et al.

Appeal No. 1998-3423
Application No. 08/584,962

ON BRIEF

Before ABRAMS, STAAB, and McQUADE, Administrative Patent Judges.
ABRAMS, Administrative Patent Judge.

ON REQUEST FOR REHEARING

This case comes before us again on request for rehearing of our decision of September 5, 2000, wherein we affirmed the decision of the examiner. The appellants requested that we reconsider certain aspects of the reasoning which led to our conclusion to affirm the examiner's positions. We have done so and, for the reasons expressed below, we have altered our decision. The Request for Rehearing is GRANTED.

OPINION

The appellants' invention relates to a folding combination tool. The following were the rejections before us on appeal, all of them under 35 U.S.C. § 103:

- (1) Claims 1-6, 12, 13 and 15-18 on the basis of Frazer in view of Newton.
- (2) Claim 14 on the basis of Frazer in view of Newton and Pullman.
- (3) Claims 1, 4-6, 12, 13 and 15-18 on the basis of Frazer in view of Schmidt.
- (4) Claim 14 on the basis of Frazer in view of Schmidt and Pullman.

In our decision, we sustained all of the examiner's rejections, thereby affirming the examiner's decision. A key factor in each of the rejections was modification of the Frazer combination tool by causing the handles to move in opposite directions between the nested position and the deployed position, rather than in the same direction, as disclosed, based upon the teachings of Newton or Schmidt. The appellants argue in the Request for Rehearing (Request) that the Board erred in five respects, the second of which focuses on the propriety of this modification. The appellants pointed to passages in column 3 of Frazer as support for their position that Frazer's invention does not work unless the handles fold in the same direction (Request, pages 6 and 7). While this point was raised on page 6 of the Appellants' Brief, we have revisited this issue in the light of all of the arguments presented in the Request, and now find ourselves in agreement with the appellants' position. Our reasoning follows.

Frazer discloses a combination hand tool with a pair of pliers jaws operated by handles. A plurality of additional implements are pivotally stowed within each of the

handles. As illustrated in the drawings, the handles and the jaws are connected together by pivots such that they are movable in the same direction with respect to one another between a nested position and a deployed position (Figures 4-6). The pivot axes are oriented at angles to each other, so that during the final phase of rotation of the jaws into the nested position (Figures 5 and 6), the handles are drawn together, causing them to become interlocked by virtue of the interaction of projections 19 on one handle with notches 20 on the other. Owing to this arrangement of elements, an advantage is provided when an additional implement, such as a knife blade, is deployed for use from inside a handle. As explained in column 3, in order to free an implement stowed in a handle for use, the jaws are rotated to the deployed position (Figure 4), whereupon the handles become spreadable and the implement can be moved to its operating position. The jaws then are rotated to the nested position (Figure 7), at which point they become interlocked. As explained in line 47 et seq.,

such interlocking allows a convenient working position for a pocket knife implement. When the jaw members are projected from the handles, a selected implement can be swung to its open position, whereupon the jaw members can be swung to their nested or retracted position so as to interlock the handles together. As shown in FIG. 7, the projected implement 9 will be in a projected working position with the interlocked side-by-side handles forming a convenient grip allowing manipulation of the implement without the danger of the implement closing on the hand of the user.

If the Frazer device were modified in the manner proposed by the examiner, that is, so that the handles moved with respect to the jaws in opposite directions, it would appear that this

feature of the invention would be destroyed. Even acknowledging that it was known in the art at the time of the appellants' invention to fold the handles of this type of tool in opposite directions to obtain other advantages, as explicitly is taught by Schmidt, the fact that the proposed modification would nullify a basic feature of the Frazer invention would have operated as a disincentive for one of ordinary skill in the art to do so.

Independent claims 1 and 16 each contain the requirement that the handles of the device be rotatable in opposite directions between nested positions wherein they are coplanar with the two jaws and adjacent thereto and deployed positions wherein they are coplanar with the two jaws and remote therefrom. On the basis of the reasoning set forth above, it is our view that the required suggestion to combine the references in such a manner as to render the claimed subject matter obvious is lacking. This being the case, it is our opinion that the combined teachings of Frazer and Newton, and Frazer and Schmidt, fail to establish a prima facie case of obviousness with regard to the subject matter recited in independent claims 1 and 16. We therefore will not sustain any of the rejections, considering that Pullman, which was additionally cited against claim 14, fails to overcome the deficiency in the other references.

CONCLUSION

Our decision of September 5, 2000, hereby is modified in the following manner:

- (1) None of the rejections are sustained.
- (2) The decision of the examiner is reversed.

The appellants' Request for Rehearing therefore is granted.

NEAL E. ABRAMS
Administrative Patent Judge

LAWRENCE J. STAAB
Administrative Patent Judge

JOHN P. McQUADE
Administrative Patent Judge

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